unpatentable over Hunt et al, claims 2, 6 and 14 unpatentable in view of Hunt et al. and Takaoka; claims 3, 7, 19, 20, 22, 27 and 31 unpatentable in view of Hunt et al. and Tsutamori et al.; claims 4 and 8 unpatentable over Hunt et al. and Uda et al., claims 10 and 12 unpatentable over Uda et al. in view of Hunt et al., claim 15 unpatentable over Hunt et al. in view of Kurahashi et al., claims 26, 30 and 34 unpatentable over Uda et al. in view of Kurahashi et al., claims 35, 36, 38-43, 45-48 and 50 unpatentable over Kurahashi et al., and claim 49 unpatentable over Uda et al. in view of Hunt et al. as applied to claim 10, and further in view of Hirono et al. Each of these rejections are respectfully traversed below.

NOTE: The responses to these rejections have been grouped **(A through H)** in terms of similar independent claims. It follows that those claims dependent thereon are allowable at least for reasons pertaining to their corresponding independent claim.

Initially, if the Examiner is not persuaded by the arguments below, Applicants kindly request an Interview in order to remove outstanding issues, clarify statements and expedite prosecution in an effort to get an indication of at least some allowable subject matter.

A. Claims 11, 25, 29 and 33.

These claims were amended to further clarify that the image output device and image information transmission device in the image

server, as well as the retrieval means in the client computer (or the transmitting, outputting and receiving steps) are performed by separate and distinct devices or components within the communication system. Modem 324 cannot therefore be each of these three claimed devices.

Applicants submit that Examiner's Office Action did not even address the new features added to the claims. Additionally, the Examiner sees a modem "as a communication device that has a function of retrieving data for two communication parties". Applicants are unclear as to what relevance this has to the features claimed. Moreover, a modem (modulator-demodulator) is a device or program that enables a computer to transmit data over telephone lines. Computer information is stored digitally, whereas information transmitted over telephone lines is transmitted in the form of analog waves. A modem converts between these two forms (i.e., digital data and analog waves. Thus, it appears that the Examiner may be stretching the teaching of a modem in order to alleges that three distinct devices and their functions are taught by the modem. For at least this reason, Applicants request withdrawal of the rejections over claims 25, 29 and 33.

B. Claims 1, 5 and 9.

Regarding these claims, Applicants incorporated a purpose or advantage served in the claims, which is not foreseen by the device in Hunt et al. The separate transmission devices are transmitting specific

data (the first device-an image data transmit command, the second device-display information related to the display device). This is significant in that having these two separable devices reduces the burden on the image server by reducing the amount or quantity of image data that the server has to process, on the basis of the display information transmitted from the client computer, an advantage which is now claimed.

The Examiner indicates that he sees "that the image quality that the display displaying is information about the display." However, the cited passages teach that a client sends a query to a server, to which a server responds; a determination is made as to whether the client can "support image customization" based on client or server supplied information, so that data is customized for the particular situation . . . so that excess data is not generated. This may arguably lead to an advantage of reducing the amount of data a server is to process. But, clearly the claimed first and second transmission devices are not both taught.

Additionally, Hunt et al. is silent on the feature regarding the data quantity reduction device's reducing the data quantity of image data to be transmitted in response to the image transmission command transmitted from said first transmission device, on the basis of the display information transmitted from said second transmission device.

For at least these reasons, Applicants submit that claims 1, 5 and 9 are allowable.

C. Claims 13, 17 and 18.

The Examiner alleges that Hunt et al. teach of an image server comprising an image data display transmission device (link 106 and server machine 304 of Fig. 3) for transmitting image data for displaying a plurality of sample images having different characteristics (size), see col. 8, line 46 to col. 9, line 5). However, the claims recite in particular:

> an image display data transmission device for transmitting image display data for displaying a plurality of sample images in side by side fashion on the display device for comparison and selection by a user, each of said sample images having different characteristics and being transmitted to said image data receiver.

This feature does not appear to have been addressed by the Examiner in his Office Action; therefore Applicants kindly request that the Examiner explicitly point out where the above feature is taught or suggested in Hunt et al., or to withdraw the rejection and indicate allowability of these claims.

D. Claims 23, 28 and 32.

In response to Applicants repeated arguments of the three distinctly claimed steps performed by the compression rate setting device of the present application, the Examiner responds that "claims 23, 28 and 32 are claiming displaying information relating to the transmission

time and not the calculated time". Applicants submit that this is an erroneous position taken by the Examiner. These claims recite the ability to:

(a) set the compression rate of image data;
(b) calculate information relating to time required for transmission in a case where the image data compressed at the set compression rate is transmitted to said image server; and to
(c) display information relating to the calculated time for transmission

There is no specific teaching of microprocessor 310 performing (a) through (c) above, as there is no disclosure related to setting a compression rate, calculating a transmission time, and displaying the calculated time. Further, this displayed time provides valued information to the user so that he/she can change the compression rate (increase/decrease) as necessary.

Fig. 6 of Hunt et al., alleged by the Examiner to show a display displaying a calculated time for transmission, illustrates a modified image file 600 divided into segments, but **says nothing about the actual positively recited steps of setting, calculating and displaying as set forth above**. Accordingly, these claims are allowable at least for the reason that these features are neither taught nor suggested by Hunt et al.

E. Claims 19, 27 and 31.

Regarding Tsutamori et al., Applicants have previously pointed out that the Examiner has either ignored or refused to give weight to each of three separate claimed features: (1) image data quantity reduction device, (2) print image area designation means and (3) partial image data extraction means.

Tsutamori's CPU 101 has neither a processing function for designating a print image area, nor a function for extracting partial image data. However, the Examiner's position is that CPU 101 **"clearly is an input controller that is the client"** and that controller 101 **"has the function of thinning image data"** (attributing this to be the partial image data extraction feature); and relies on the abstract **"to fit picture elements in the frame"** in alleging that the print area designation means is taught.

However, what is actually recited in these claims is that the client computer has an image data quantity reduction device that **further includes** the claimed print image area designation means and partial image data extraction means. These are fairly specific features that the Examiner alleges is taught by CPU 101; yet his alleged support in Tsutamori appears incomplete and at best a stretch of the reference, since the Examiner attempts to piece together the elements of the claims using broad conclusory statements .

Case law is favorable to Applicants position. The test for an implicit showing in making obviousness-type rejections is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *See* In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. *See* In re Dembiczak, 50 USPQ2d 1613, 1617 (Fed. Cir. 1999). **Broad conclusory statements standing alone are not "evidence."**

The Court of Appeals for the Federal Circuit (CAFC) has applied this test *in* In re Kotzab 55 USPQ2d 1313 (Fed. Cir. 2000). In Kotzab, the invention was directed to an injection molding method for forming plastic articles, where the temperature of the mold is controlled so that the plastic can harden uniformly throughout the mold. The problem confronted by Kotzab was providing temperature control to ensure the quality of the final product with a short molding cycle time. Independent claim 1 of the Kotzab application recited controlling, via a single sensor, a plurality of flow control valves. However, this claim was rejected by the Board of Patent Appeals and Interferences (BPAI) under 35 U.S.C. §103(a) in view of WO 92/08598 to Evans.

A first embodiment in Evans disclosed a single zone system, where a single sensor was used to control a single value. A second embodiment

in Evans disclosed a multiple zone system, where a sensor system (composed of multiple sensors) was used to control multiple valves. The BPAI found that one of ordinary skill in the art would combine the single zone embodiment of Evans with the multiple zone embodiment of Evans in order to obtain an arrangement where one sensor controlled multiple valves.

In reversing the BPAI, the CAFC stated that a rejection cannot be predicated on the mere identification (in the prior art) of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected (the claimed components) for combination in the manner claimed. The CFAC held that there was not enough evidence to support the conclusion that for a plurality of control valves in a multiple zone setting, only one temperature sensor should be used to provide control for the plurality of valves.

In Kotzab, the CAFC further held that the BPAI fell into the hindsight trap with respect to Kotzab's apparently simple invention. The CAFC admitted that the idea of a single sensor controlling multiple valves as a opposed to multiple sensors controlling multiple valves was a technologically simple concept. However, the CAFC held that the BPAI produced no findings as to the specific understanding or principle within the knowledge of the skilled artisan that would have motivated one with no knowledge of the Kotzab invention to make the combination in the

manner claimed. Accordingly, the CAFC concluded that the BPAI did not make out a proper prima facie case of obviousness under 35 U.S.C. §103(a) in view of Evans, and reversed.

Claims 19, 27 and 31 recite interrelationships between the elements that make up the data reduction device that are not taught or suggested by Tsutamori. The fact that the Examiner is applying individual components from various parts of the Tsutamori disclosure to reject the claims is impermissible in light of the holding in Kotzab. For this reason, withdrawal of the rejection is kindly requested.

F. Claims 10 and 12.

Regarding these claims, Applicants have previously explained that the passage cited by the Examiner in Hunt et al., says **nothing** about performing color conversion processing whatsoever, specifically color conversion processing based on a characteristic of the display. More particularly, neither reference cited by the Examiner teaches at the very least the claimed second color conversion device for performing second color conversion processing on the read image data in accordance with a characteristic of the display device.

The Examiner even admits that Uda et al. is silent on the second color conversion device, but submits that Fig. 1, Fig. 3 and col. 9, lines 1-5 of Hunt et al. teach "to use a display in a client computer for display data transmitted from a server". However, the claims call for "performing

second color conversion processing on the read image data in accordance with a characteristic of the display device." Thus Applicants submit that the disclosure relied on by the Examiner still does not meet this feature, and request that the rejection be withdrawn.

G. Claims 26, 30 and 34.

These claims were amended to further define exactly what part of the printing template image data is received "a part of printing template image data, which is transmitted from said image server and represents a part of a window-synthesizing user image, and which is used for printing processing in said printer.

The Examiner contends that elements 311 and 314 in Kurahashi et al. (a network connection processing unit and image processing editing unit) receive and synthesize the claimed part printing template image data; and points specifically to Fig. 1 in Hunt et al. to allege that the data "represents part of a window synthesizing user image". However, fig. 1 illustrates an original image that is broken up into "leaf nodes" (the duck, "Wow", thought bubbles") that represent parts of the original image.

In contrast, a part of a window-synthesizing user image, as claimed in these claims can be seen in Fig. 30b of the present application. The entirety of the window-synthesizing user image is a circle (window W, see Fig. 26), but the part of the "circle" is a sector (90°)

as shown in Fig. 30b. Hunt's Fig. 1 is a complete circle; it therefore cannot be the claimed part, which, as read in light of the specification, indicates a sector or something less than a full circle. Withdrawal of the rejections as pertaining to these claims is therefore kindly requested.

H. Claims 35, 41, 42 and 48.

In Applicants previous negotiations with Examiner Poon, he explained that he was unsure of the distinction between "editing" and "re-editing", since either could be construed as editing. Applicants clarified this in the previous response.

Accordingly, there is nothing suggestive in Kurahashi et al. **whatsoever** that is directed to re-editing of the initially edited image. Secondly, even assuming *arguendo* that Kurahashi et al. analyze editing data (col. 7, line 3), Kurahashi still does not judge whether initial editing or subsequent re-editing is allowed based on a transmitted execution command, as is claimed. In col. 6 of Kurahashi et al. (lines 45-56), all that is described are the elements and their functions of Fig. 3. None of these elements teach of subsequent re-editing in any respect, especially re-editing based on a transmitted execution command. Accordingly, withdrawal of the rejections as pertaining to these claims is kindly requested.

Finally, regarding each of the pending dependent claims, these claims are allowable at least for the reasons set forth above regarding

their corresponding independent claim, and/or for the further features claimed therein.

Conclusion

As indicated, if not persuaded the Examiner is respectfully requested to contact Matthew J. Lattig (Reg. No. 45,274) at the telephone number of the undersigned below in order to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to the provisions of 37 C.F.R. § 1.17 and 1.136(a), Applicants hereby petition for an extension of one (1) month to May 3, 2001 for the period in which to file a Response to the outstanding Office Action. A check in the amount of $110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

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